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EXAMINER

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/752,611
Filing Date: December 29, 2000
Appellant(s): BARILE, STEVEN E.

MAILED

MAR 24 2006

Technology Center 2600

Shireen Irani Bacon
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/22/2005 appealing
from the Office action mailed 5/19/2005.

Art Unit: 2644

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,6,75,708	FITZPATRICK	10-1997
US 2001/0027396 A1	SATO	10-2001

Art Unit: 2644

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

(I) Claims 1-2, 5-8, 10-12, 15-17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (US 2001/0027396 A1) in view of Fitzpatrick et al (USPN 5675708). Hereafter, "Fitzpatrick et al" will be referred to as "Fitzpatrick".

Sato discloses the audible synthesis an emission of data related to an audio file, relative to the playing of the audio file. The data involves information about the audio file ranging from the title to the type of the music (page 3, para. 0065, and Figure 90). The data is passed through a voice synthesizer (23) to convert the data into an audible output compatible format and the data is output in various forms of in synchronism with the audio file, ranging from the start or end of the audio file to a detected volume condition of the file (para. 0053, 0074, 0075). Regarding **Claim 1**, the selection of the relevant audio data with the extraction unit (21) for the voice synthesizer (23) reads on "reading descriptive information about an audio file from meta-data for the audio file" (para. 0061). The synchronism between the playing of the audio file and the audio data from the synthesizer reads on the *concept* of "concatenating at least a portion of an audio format of the descriptive information". However,

Art Unit: 2644

the data from the synthesizer (23) is passed through a D/A converter before it is chronologically associated with the audio data of the audio file.

Thus, Sato does not clearly specify:

- that the concatenating of the at least a portion of the audio format of the descriptive information is executed to an audio file

Fitzpatrick discloses a system for converting various forms of multimedia data into audio media. The process involves the inputting of a file or multimedia data stream (col. 3, lines 17-22). The process involves aligning entities from a file on a modified output file (col. 3, lines 66-67 and col. 4, lines 1-6). Entities include text word or phrases that may be converted to a spoken word, as well as audio elements (col. 3, lines 43-46 and 57-61). The entity that is written to output file is the associated digitized audio format of the entity (col. 4, lines 1-2). Fitzpatrick also discloses a process for providing an audio equivalent for data that does not have a standard, discernable equivalent (col. 4, lines 8-34). The concept of writing multiple digital audio entities to a file, in view of the effective signal composition of Sato, reads on "concatenating the descriptive at least a portion of an audio format of the descriptive information to the audio file".

To one of ordinary skill in the art at the time the invention was made, it would have been obvious to perform the signal combination of Sato in the digital domain though a method such as the

Art Unit: 2644

subsequent writing of entities as disclosed by Fitzpatrick. The motivation behind such a modification would have been that such digital processing would have not required hardware capable of efficient processing for the real time production of output.

Regarding **Claim 2**, the voice synthesizer (23) of Sato converts the text information to voice data, which is provided through D/A converters (13a,13b) to be emitted by a loudspeaker, the functions of the synthesizer reading on "converting the descriptive information to the audio format prior to concatenating" (para. 0059). Fitzpatrick also notes certain text data as convertible to a spoken phrase (col. 3, lines 57-61).

Regarding **Claim 5**, one embodiment of Sato involves deriving the data information from the ID3 tag of an MPEG-1 Layer 3 format, which reads on "the audio file comprises the metadata" (para. 0065). Sato also notes that such data can be shown on a device with a text display, and that the disclosed combination may be executed on a device with a display, which provides support for retaining such data in the output file produced by Fitzpatrick (para. 0007,0094).

Regarding **Claim 6**, please refer to the like teachings of Claim 1, noting that one of the synchronism options involves outputting the data information at a certain time after the start of the playing of an audio file, which reads on the concept of "mixing" (para. 0072). It is noted herein that the implementation of such a process, in view of the desirable modification proposed above, would involve performing such mixing in the digital domain, again, with the motivation being

Art Unit: 2644

the elimination of the requirement of components capable of real time processing. Such digital addition or mixing is substantially well known in the art, support for which can be found, for example, in Farhangi et al (USPN 5647008), which has been included with this office action. In the teachings of Fitzpatrick, the resultant signal is written to a new file designated as an output file (col. 3, lines 22-24 and col. 4, lines 1-2 and 63-67). This process of writing of entities reads on "generating a new audio file containing audio data resulting from the mixing".

Regarding **Claim 7**, please refer to the like teachings of Claim 2.

Regarding **Claim 8**, the start reproduction time is one of the synchronization options, which reads on "at least a portion of the audio format of the descriptive information is mixed with audio at the beginning of the audio file" (para. 0070).

Regarding **Claim 10**, please refer to the like teachings of Claim 5. Regarding **Claim 11**, please refer to the like teachings of Claim 1, noting that Sato discloses the text information read out program as being recorded on a computer readable recording medium (para. 0108). Regarding **Claim 12**, please refer to the like teachings of Claim 2. Regarding **Claim 15**, please refer to the like teachings of Claim 5. Regarding **Claim 16**, please refer to the like teachings of Claim 1, noting that the program is installed on a computer system (Figure 2) from a readable recording medium (para. 0108). Regarding **Claim 17**, please refer to the like teachings of Claim 2. Regarding **Claim 20**, please refer to the like teachings of Claim 5.

Art Unit: 2644

(II) Claims 3-4, 9, 13-14, and 18-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sato in view of Fitzpatrick as applied above, and further in view of Yumura et al (USPN 5834670). Hereafter, "Yumura et al" will simply be referred to as "Yumura".

As detailed above, Sato discloses a system for selectively including information about an audio file into the audible playing of the audio file. Sato discloses a variety of timing at which the audio file information may be emitted by the speaker (14) in relation to the playing of the audio file. Fitzpatrick discloses the notion of digitally combining audible parts of an input file into a different file.

However, Sato in view of Fitzpatrick does not specify:

- that the audio format of the descriptive information is concatenated to the beginning of the audio file

Yumura discloses a system for audibly presenting information about a song and the user requesting a song in a karaoke system. The audio file name and requester's name are input to a local terminal of the karaoke system with an input device (23). This information, processed by a speech synthesis unit (25) influenced by genre of the song, is output to the speakers during an introduction, interlude, or just before a song (col. 3, lines 13-35). The playing of the song information data reads on "at least a portion of the audio format of the descriptive information is concatenated to the beginning of the audio file".

Art Unit: 2644

To one of ordinary skill in the art at the time the invention was made, it would have been obvious to incorporate the emission of the song data before the playing of song as taught by Yumura into the system of Sato in view of Fitzpatrick. The motivation behind such a modification would have been that such an arrangement would have enabled users of the system to directly identify information regarding a song to be played before the actual playing of the song. Playing the song data before the actual song would have left the song to be heard in its original form and prevented any unpleasant sound caused by the overlapping of the music and synthesized voice data.

Regarding **Claim 4**, the system of Yumura involves a main computer source which stores song information and a terminal computer source which requests and plays the stored music (col. 2, lines 44-67). Song data is transmitted from the main unit (1) and the terminal (2), and the synthesis of the song title and other information involves the use of data received in this transmission (col. 3, lines 15-18). This aspect of the invention, which improves the quality of the synthesized audio, reads on "the concatenating is performed in response to an operation to transfer the audio file from a first computer system to a second computer system".

Regarding **Claim 9**, please refer to the like teachings of Claim 4.

Regarding **Claim 13**, please refer to the like teachings of Claim 3.

Regarding **Claim 14**, please refer to the like teachings of Claim 4.

Regarding **Claim 18**, please refer to the like teachings of Claim 3.

Regarding **Claim 19**, please refer to the like teachings of Claim 4.

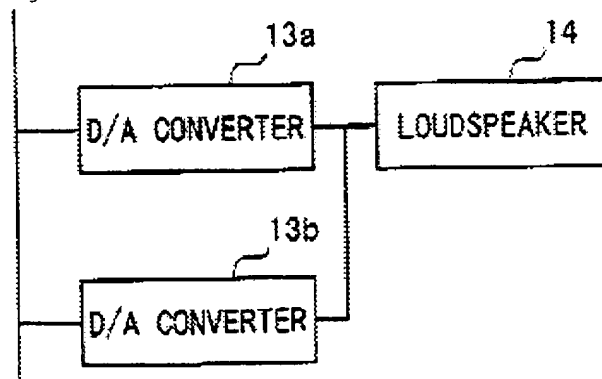
(10) Response to Argument**(I) Summary of Rejection**

Two groups of rejections were presented in the final office action, the first combining the teachings of Sato in view of Fitzpatrick and the second combining the teachings of Sato in view of Fitzpatrick in further view of Yumura. The first group of rejections demonstrated each of the independent claims (1,6,11,16) in the present application as obvious and thus not patentable. Both groups were rejected under 35 U.S.C. 103(a). Notwithstanding the other basic criteria, the application of references under this statute sets the requirements for the prior art to be at teaching or *suggesting* all claim limitations as claimed, as noted in MPEP 2143.

As applied in the above rejection, Sato delimits the basic concept - the synthesis and playback of text information from an audio file with the sound or music from the same audio file - underlying the present application, as claimed. Sato also includes details regarding the particulars of the implementation behind such a concept, though not all of the details of implementation as claimed. The teachings of Fitzpatrick, however, remedy this difference in implementation between the teachings of Sato and the present application as claimed. The teachings of Fitzpatrick also provide motivation for utilizing the manner of implementation denoted in Fitzpatrick, thereby establishing a *prima facie* case of obviousness.

Art Unit: 2644

Specifically, Sato discloses a system that produces an audible signal that includes audible information concatenated after or mixed with audio/music signals to which the audible information pertains, wherein the audible information and the audio/music signals are originally derived from the same audio file (abstract, para. 0009-0016). Thus, as noted with more particular citations above, Sato teaches "A method comprising reading descriptive information about an audio file from meta-data for the audio file; and concatenating at least a portion of an audio format of the descriptive information" as claimed in claim 1. Such an interpretation of Sato pertaining to the claim language involves interpreting the 'audio format' of Sato to be the analog format of the signal output from the A/D converters (13b) and the 'concatenation' to take place at the connection point (see Figure 2, reproduced at



From Figure 2 of Sato, showing connection or 'concatenation' of signals that are output through loudspeaker 14.

right) where the outputs of the two D/A converters (13a-b) connect to create a composite output signal for the speaker (14). The timing of this combination of analog signals can be controlled in Sato to be during or after the music signal (para. 0089-0094). However, the claim language recites "concatenating ... an audio format ...to an audio file" or "mixing... an audio format... with the audio file", which requires the claimed "audio format" to be digital, thus meaning that the claimed 'concatenation' or 'mixing' takes place between two

Art Unit: 2644

digital signals, treating the signals in the digital domain. Thus, while Sato teaches an analogous combination of audio signals, the combination of Sato is performed in the analog domain. However, Fitzpatrick teaches that digital audio signals, whether representing audio sounds or text that converted to a spoken word, can be combined into an audio output file (col. 3, line 57-col. 4, line 2). The implication of such an output file in the system of Fitzpatrick is that non-efficient or less-efficient hardware may perform the media conversion process (col. 5, lines 8-13, for example). This can be contrasted with the system of Sato wherein the real time, direct-to-speaker output requires the efficient, multi-tasking operation of the CPU and at least two D/A converters to extract, transfer, synthesize, synchronize, volume monitor, and D/A convert digital audio and related data (para. 0055-62 and 0070-0086, for example). In Fitzpatrick, the sequential writing of digitized audio data into an output file, specifically preceded by a header and followed by a concatenation of an end-of-file pointer (col. 3, lines 22-26 and col. 4, lines 1-2, 35-37, 50-53, and 63-65), at least suggests the claimed "concatenating... to the audio file" of "mixing.. with the audio file", particularly in view of the desire in Sato to place the synthesized information during or at the end of the file (para. 0089-90). The art-appropriate interpretation of this "concatenating" will be further discussed below, with regards to a particular argument by the applicant. However, as summarized and detailed further above, Sato in view Fitzpatrick at least suggest the methods and apparatuses of the

Art Unit: 2644

present application, so far as said methods and apparatuses are claimed and considered as a whole.

(II) Summary of the Applicants Arguments

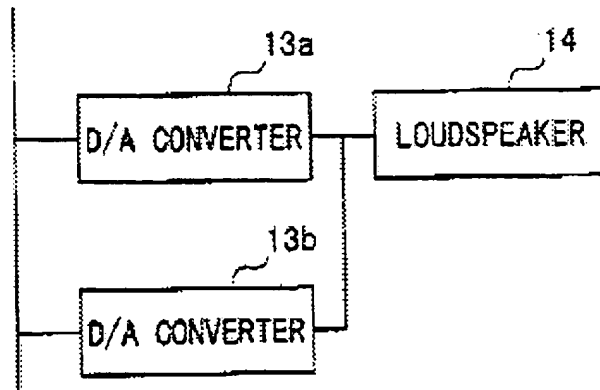
The applicant's remarks and position fail to appreciate that the rejections of the final office are applied under 35 U.S.C. 103(a), and as such, involve at least involve what the reference collectively suggest. The applicant's remarks also further fail to appreciate that limitations in question are rejected in view of a combination of references, not single references alone. Per MPEP 2145, it is known that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. The applicant also appears to argue that since the reference of Fitzpatrick can process a broader range of input files (or "do more") than just audio files, that the teachings found therein cannot be applied to Sato. The examiner respectfully disagrees, as is further detailed below.

(III) Specific Responses to Applicant's Remarks

On page 5, lines 1-2 , the applicant has stated, "Rather than concatenating the synthesized voice to the audio file, Sato simply plays the synthesized voice through a speaker" and "Applicants respectfully assert that rendering of audio information from a synthesizer is not concatenation". The examiner respectfully notes however, that the output of the synthesizer is applied via a D/A

Art Unit: 2644

converter to the same signal line as that which carries the music audio signal (see figure at right, in view of para. 0059, wherein the loudspeaker 14 converts both analog signals). So far as



these analog signals are both applied through the same loudspeaker, this combination of signals at or before the speaker 14, particularly in view of the "end of piece" or "predetermined period of passing time" synchronization timings, at least teaches the "concatenating" of the synthesized text information in an audible format to the audio data of the audio file. The further applied teachings of Fitzpatrick (as well as the applicant's own specification) substantiate that this concatenating or mixing, as delimited and intended to be interpreted in the pending claim language, is not patentable over the teachings of Sato in view of Fitzpatrick, as applied in the final office action.

In a related remark, on page 5, lines 9-14, the applicant has stated, "During prosecution, the Examiner asserted regarding the Sato reference that 'the synchronism between the playing of the audio file and audio data from the synthesizer reads on the concept of 'concatenating at least a portion of an audio format of the descriptive information'" and "The Examiner appears to have backed off from this position (see following paragraph), but Applicants wish to assert their argument against this position for the record". As

Art Unit: 2644

discussed in the above paragraph, the examiner has not "backed off" this position. Sato does teach this *concept* (emphasis added), as worded in the final rejection, but not this concept in the digital format as particularly claimed. Specifically, the phrase "to an audio file" has been interpreted to mandate the concatenation or mixing to take place in the digital domain between digital audio signals. However, Sato still teaches the fundamental, underlying process, even the steps are performed in a different format (digital instead of analog). Sato, in comparison, concatenates or mixes an audio format (analog) of the descriptive information to or with an audio signal indicative of the audio file, not "to" or "with" the components of the initial audio file, in their digital file format, itself.

At this point it should be noted that the pending claim language of "concatenating... an audio format... to the audio file" and "mixing an audio format ... with the audio file" is marginally ambiguous or at least misleading with respect to the technical arts represented by such a choice of language. Such language, at face value, appears to denote literally taking an audio file, stored in a certain space in a memory, and directly tacking the audibly formatted meta-data information to the space in series behind or before the space occupied (or logically occupied) by the audio file. This implication, though, conflicts with the applicant's own specification as well as the technical details of audio files. As is notoriously well known in the arts, files traditionally have non-audio data at the beginning and end of the files, respectively known as headers and end delimiters (or

Art Unit: 2644

end-of-file pointers). Fitzpatrick substantiates this position at least with respect to the input media files as well as the output file created therein (see col. 3, lines 22-26 and 54-57 and col. 4, lines 58-65). The applicant's own specification also admits that audio files have meta-data stored after audio data at the end of the audio file (page 3, line 8-10). Thus, literally concatenating the audio format of the descriptive information, which implies concatenating to the end or beginning of the audio file, would result in an improper file format. This format would be improper because the audible format of the descriptive information would not be found or recognized by existing playback programs (noted by applicant, page 4, lines 23-25) since it is before or after the data that indicates that the beginning or end of the file has been encountered (and thus, no more data for playback is in the file, per such end or beginning markers, even though the literal interpretation of the pending claim language would result otherwise). The 'concatenating' of the independent claims must be interpreted as potentially being 'before' or 'after' any file format, so far as claims 3 and the like further define such concatenating as 'to the beginning'. The fact that there may be no auxiliary data at the beginning or end of the audio file is irrelevant so far as the details of the audio file format are not claimed. However, this literal interpretation is not what is intended by the applicant, as is evidenced by the applicant's own specification. See page 6, lines 17-19; page 7, lines 18-20 and 23-28, for example. As detailed in these lines, "concatenating... an audio format... to the audio

Art Unit: 2644

file" involve concatenating the audio formatted descriptive information (138) to the audio content (118) of the audio file (132), not to the audio file (132) itself (which again, would potentially cause the above problems of making the added data not read or found by a file playback program). This form of concatenating, putting or writing audio formatted signals (including audio sounds and text that can be converted to a spoken word, such as in audio file of Sato) in adjacent positions, is the same form of 'concatenating' as performed in Fitzpatrick and, so far as human discernable (audio) formatted entities, including audio sound and converted text, would be written sequentially into the output file. This limitation in the claims has been interpreted in light of the technical suggestion of the applicant's specification (concatenating to the audio content in an audio file), as is further applied in the rejection above, particularly with respect to the application of the Fitzpatrick reference.

A similar interpretation must be -and has been- applied to the 'mixing' limitation of Claim 6. Literally 'mixing an audio format... with the audio file" would inherently create a new file, since the original audio file would be modified by the mixed in audio format. However, Claim 6, recites the additional, separate step of 'generating a new audio file', thus indicating that the 'mixing... with the audio file' is not to be interpreted literally as mixing 'with the file', else the 'generating' step would be superfluous. Such literal 'mixing' is also an incorrect interpretation of the claim language of

Art Unit: 2644

claim 6 because it suggests that the 'audio format' may be mixed with the metadata of the audio file, which is also an improper file format so far as the added audible format of the descriptive information would not be found or recognized for playback with other audio data by existing playback programs (noted by applicant, page 4, lines 23-25), since it would be in the metadata area instead of the expected audio data area. Similar to the concatenating above, this 'mixing' is intended to be technically interpreted as mixing the audio title (138) with the audio content (118) of the audio file (132) (see page 7, line 28- page 8, line 5 of the applicant's specification as originally filed), not the broad and ambiguous implication of "mixing... with the audio file". To reiterate, reading the 'mixing' limitation of Claim literally would invoke enablement as well as written description problems as noted above. The final rejection, as well as this examiner's answer, have considered this limitation in view of the appropriate, technical interpretation of the claim language, as is substantiated by the applicant's specification.

On page 5, lines 19-20, the applicant has stated, "The Office Action attempts to remedy this deficiency in the prima facie showing of obviousness by relying on Fitzpatrick. However, such reliance must fail". It is respectfully noted that the context of "must fail" is unclear.. The applicant appears to suggest that Fitzpatrick *inherently* cannot remedy the alleged deficiencies of Sato. The logic behind this statement is not readily apparent, as it suggests that the teachings of Fitzpatrick are altogether irrelevant, regardless of what they do

Art Unit: 2644

or do not contain. Note the difference between phrase "does fail" and the chosen phrase of "must fail". Regardless, the teachings of Fitzpatrick *can remedy* the deficiency of Sato and *do remedy* this deficiency as discussed above and further demonstrated below with regards to the applicant's remaining arguments.

On page 5, lines 25-28, the applicant has stated, "Neither Sato nor Fitzpatrick, alone or in combination, discloses, suggests or teaches 'concatenating at least a portion of an audio format of the descriptive information to the audio file' (Claims 1, 11, and 16, in part, emphasis added)" and "Fitzpatrick discloses instead translating or converting a multimedia data stream or file to an audio media". The examiner respectfully disagrees. Sato in view of Fitzpatrick at least suggests this limitation. As detailed above, the technical implication of "concatenating... to the audio file" is that the synthesized contents information data is concatenated to the audio music data, as noted in the applicant's specification. To infer otherwise would invoke enablement and written description issues, as discussed above. The use of different descriptive language does not change the underlying technical meaning of said language, again, which is described in the applicant's own specification. Sato discloses that voice-synthesized contents information can be mixed over or played back after the music to which it pertains. Fitzpatrick teaches that the playback of synthesized text information and music from the same file may be combined into a single file for output. The alleged 'translating or converting' of Fitzpatrick (understood to be the

Art Unit: 2644

sequential writing of digitized audio to the output file, col. 3, line 66 - col. 4, line 2) is the same technical process of 'concatenating' as present in the pending claims, as is further demonstrated by the applicant's own specification. These two sets of teachings, particularly in view of the 'end of song' playback option of Sato at least suggest "concatenation... to the audio file" as properly interpreted in view of the applicant's specification.

On page 6, lines 3-4, the applicant has stated, "The Fitzpatrick input file is not an audio file -- it may include video elements, graphical elements, document format control, etc.". The examiner respectfully notes that this statement in and of itself substantiates the fact that the input file of Fitzpatrick *may* be an audio file. Just as the input file *may* include the video, graphical, and such elements, it also *may not*, again, as evidenced even by the applicant's own choice of language. Regardless, the limitation was rejected by considering Sato in view of Fitzpatrick, not Fitzpatrick alone. The text and music input file in Sato is clearly an input audio file (mp3 recording method) (para. 0065, for example). The system of Fitzpatrick can clearly process such a file, as evidenced by the flowchart shown in Figure 2 and the potential inclusion of audio sound and text words of phrases, col. 3, lines 41-53, in the input file. The 'audio file' or mp3 formatted file of Sato is one form of 'multimedia file' so far as it includes both text (visual) and audio (audible) types of media.

Art Unit: 2644

On page 6, lines 9-12, the applicant has stated, "They [the Final Office action, as reiterated in the Advisory Action] argue that, because one can go from beginning to end of the flowchart shown in Fig. 2 of Fitzpatrick without traversing blocks 320 - 380, Fitzpatrick discloses processing for an audio-only file such as a file having the music data shown in Sato". The examiner respectfully notes that this statement fails to note that the mp3 formatted file of Sato includes both audio and text data (para. 0065, for example); as such, depending on the applicant's intended interpretation of the phrase 'audio-only', the file of Sato is more appropriately called a 'audio-and-text-only' file. Again, the system of Fitzpatrick would be able to handle such a file, for example, through two passes through the 250-270 branch in Figure 2, one pass for the audio data and one pass for the text data shown in Figure 9. As stated, above, Sato explicitly teaches an audio-text file (mp3), and Fitzpatrick discloses a method of processing that would have been applicable to such an audio file.

On page 6, lines 9-16, the applicant has stated, "They argue that, because one can go from beginning to end of the flowchart shown in Fig. 2 of Fitzpatrick without traversing blocks 320 - 380, Fitzpatrick discloses processing for an audio-only file such as a file having the music data shown in Sato" and "However, such is not the case" and "One cannot traverse from beginning to end of the flowchart in Fig. 2 without executing block 225" and "At block 225, a counter regarding audio entities in the file is initialized to zero" and "Thus, it is anticipated that non-audio entities may be encountered in

Art Unit: 2644

the input file". The examiner respectfully notes, however, that block 225 is not between or in the path of blocks 320-380. Thus, the applicant has failed to even contradict the characterization of the Final Office and Advisory Actions that the applicant's own response has presented. This would then suggest that "such" is the case, that Fitzpatrick discloses processing compatible or for audio-text-only files including the music data file shown in Sato.

The statement from lines 15-16, that "it is anticipated that non-audio entities may be encountered in the audio file" also supports the position reiterated herein, that the system of Fitzpatrick would have been compatible with the music and text data of Sato. Again, the applicant's response uses the word 'may', which necessitates the possibility of 'may not', the latter of which being applicable to the input of Sato. Regardless, 'may' does not mean 'must' or indicate inherency. The data of Sato meets the definition of 'multimedia' in Fitzpatrick by its inclusion of both audio sound and convertible-text data. As such, the methods, systems, and teachings of Fitzpatrick would have been appropriate for and applicable to the types of data and processing performed in the system of Fitzpatrick. The applicant also appears to be suggesting that since Fitzpatrick can handle a broader array of data, including graphics and video than that which is addressed in Sato or the present application, then such teachings of Fitzpatrick are not applicable under 35 U.S.C. 103(a) for the lesser set of sound and text multimedia data present in the input of the system of Sato. The examiner respectfully disagrees. Fitzpatrick's

Art Unit: 2644

ability to do more - to process more diverse multimedia files - does not prevent its application to the teachings of Sato for at least processing multimedia files with text and audio. Together, the teachings of Sato in view of Fitzpatrick at least suggest an 'audio file' (or a file comprising 'audio content', as further detailed above with regards to the discussion of 'concatenating...to the audio file').

On page 6, lines 23-26, the applicant has again reiterated, "Neither one discloses, teaches or suggests 'concatenating at least a portion of an audio format of the descriptive information to the audio file' for which meta-data has been read". The examiner respectfully disagrees. As stated in the above rejection, Sato discloses the combination of music and synthesized text information for output from the same file and Fitzpatrick discloses a processes for digitally combining the sound and synthesized text data from the same file for the purpose of output or playback. Together, in view of the details further discussed above, these references at least suggest the methods and apparatuses as claimed.

On pages 7 and 8, the applicant continues to address the teachings of Sato and Fitzpatrick. As is clearly evident, the applicant's remarks continue to attack the references of individually. The applicant's remarks repeatedly attack the references for limitations that they were not relied upon as teaching or at least suggesting, or not relied upon as at least suggesting alone. This is an ineffective way of showing nonobviousness, as is noted in MPEP 2145.

Art Unit: 2644

On page 7, lines 10-11, the applicant has stated, "Neither the Sato or Fitzpatrick reference teaches, discloses, or suggests 'generating a new audio file containing audio data resulting from the mixing'". The examiner respectfully disagrees. Sato clearly teaches mixing the audio signals that represent the music and synthesized text information (reading-out of synthesized data during reproduction of music data, para. 0050-0053, which is simultaneous reproduction, hence 'mixing', particularly in view of combined signal line/output over speaker 14, Figure 2). Fitzpatrick discloses the putting together of such data (sound and synthesized text) into an output file (col. 3, lines 22-26, 66-7 and col. 4, lines 1-2 and 58-67). The combining of data into an output file in Fitzpatrick in view of the manner of combining such information (mixing) in Sato, and vice versa, at least suggests 'mixing an audio format of at least a portion of the descriptive information with the audio file' and 'generating a new audio file containing audio data resulting from the mixing'".

On page 7, lines 15-16, the applicant has stated, "Applicant's do not claim 'handling' of digital audio signals". The examiner respectfully disagrees. Each of the independent claims recite "concatenating" or "mixing" digital audio data. These are two forms of 'handling' digital audio so far it was used in the Advisory Action to refer to the teachings of Fitzpatrick. Fitzpatrick teaches the particular claimed 'concatenating' form of digital audio data 'handling', in view of the serial reproduction of Sato, and Sato in view of Fitzpatrick is considered to at least suggest the particular

Art Unit: 2644

'mixing' form of digital audio data handling. The applicant has neither addressed nor refuted what the collective teachings of Sato in view of Fitzpatrick at least suggest, as was applied in the final office action.

On page 7, lines 17-18, the applicant has stated, "As is argued above, Sato does not disclose, teach or suggest 'generating a new audio file containing audio data resulting from the mixing'". Again, the examiner respectfully notes that this argument is moot since Sato, alone, was never said to teach or suggest this limitation. Rather, Sato in view of Fitzpatrick was considered to at least suggest this limitation. Regarding this limitation, Sato is considered to teach 'generating a new audio signal containing an audio signal resulting from the mixing', while Fitzpatrick, in view of the processing and combination of signals in the digital domain into a new output file, at least suggests embodying such a new signal in an audio file.

On page 7, line 20, the applicant has stated, "Sato does not generate an output file". Again, the examiner respectfully notes that this argument is moot since Sato, alone, was never said to teach or suggest this limitation. Fitzpatrick discloses the generation or "writing" of pieces to an output file, which at least suggests the claimed "a new audio file" (steps 220,260,280, Figure 2 of Fitzpatrick, for example).

On page 7, lines 21-23, the applicant has stated, "Similarly, Fitzpatrick also fails to disclose, teach or suggest 'generating a new audio file containing audio data resulting from the mixing', at least

Art Unit: 2644

because Claim 6 recites that the mixing relates to 'descriptive information' about the audio file". Again, the examiner respectfully notes that this argument is moot since Fitzpatrick, *alone*, was never said to teach or suggest this limitation. Rather, Fitzpatrick discloses that digitized data representing text and sound from an input file, and Sato teaches or at least suggests that such a text is descriptive information' (para. 0065) and that such information is combined via mixing (Figure 8 and simultaneous reproduction, bottom portion of Figure 1). One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. Accordingly, this and other such arguments by the applicant are unpersuasive.

On page 7, lines 23-25, the applicant has stated, "Because Sato does not show the generating of an audio file, the Examiner's rejection must fail because, as is discussed below, Fitzpatrick does not show this element either". The examiner respectfully notes, however, that generating an audio file (and Fitzpatrick's alleged failure to show this element) is not 'discussed below' in the applicant's brief. A conclusion is noted in line 20 of page 8, but no support is present in the remarks preceding this statement, which instead discuss additional, unapplied features of Fitzpatrick, but not the features for which Fitzpatrick was specifically relied upon for in the final rejection. The applicant's remarks do not address nor contradict that the output file of Fitzpatrick (col. 3, lines 22-26, 66-7 and col. 4, lines 1-2 and 58-67), which is written during the

Art Unit: 2644

processing of the input file, at least suggests 'generating a new audio file containing audio data'. Accordingly, writing this 'output file' is understood to at least suggest the generating of the new audio file as claimed, in further view of the simultaneous reproduction (thus, mixing) teachings of Sato in regards to the manner in which data is combined. Again, the motivation behind combining such teachings would have been that such digital processing would have not required hardware capable of efficient processing for the real time production of output, as is suggested by the teachings of Fitzpatrick (col. 5, lines 8-13).

On page 8, lines 3-5, the applicant has stated, "However, Fitzpatrick does not disclose, suggest or teach that the human discernible entity may be meta data that includes descriptive information about an audio file, as recited in Claim 6". Again, the examiner respectfully notes that this argument is moot since Fitzpatrick, alone, was never said to teach or suggest this limitation. Rather, Fitzpatrick discloses that an input file may contain a text word or phrase which can be converted to spoken word or phrase and Sato, was relied upon in the final rejection, more particularly discloses that such text with a file may convey descriptive information (discussion of metadata in Sato, para. 0065 and Figure 9, as noted in regards to Claim 1, which was referenced in the rejection of Claim 6).

On page 8, lines 10-13, the applicant has stated, "Indeed, Fitzpatrick teaches away from the technique of Sato" and "That is, the

Art Unit: 2644

problem that Fitzpatrick seeks to solve is the loss of non-discernable data that the human ear cannot understand (such as video or graphics data) from a converted audio file. See Fitzpatrick, Col. 3, lines 57 - 61". The examiner respectfully disagrees. The citation provided by the applicant from column 3 discloses types of non-discernable data, but not that this data is the sole or whole problem sought to be solved by Fitzpatrick. Again, the applicant appears to be arguing that since the teachings of Fitzpatrick can be applied to a broader array of multimedia files than those found in Sato, the teachings of Fitzpatrick are not applicable to the types of files handled in Sato. The basis of this argument is not clear, nor is it persuasive. The applicant has provided no evidence nor documentation to support this position; arguments of counsel cannot take the place of factually supported objective evidence. As understood by the Office, the additional features or capabilities of Fitzpatrick does not constitute "teaching away", so far as it would not lead away from the claimed invention. On the contrary, the purpose of the system of Fitzpatrick, as is stated by Fitzpatrick, is media boundary transversal, comprising the transformation of a multimedia file to and from an audio output that includes portions understandable to humans while preserving both the discernability of the human discernable output to the unaided human ear and also the integrity of the underlying data (col. 1, lines 59-col. 2, line 5). Nothing in this purpose requires that the system of Fitzpatrick actually be applied to an input file with non-discernable data, just as blocks 320-380 are not necessarily included

Art Unit: 2644

in a path from Start to Stop in Figure 2, even if the capability to handle such entities is there. The system of Fitzpatrick would still convert the input file to and from the disclosed audio media, traversing the visual media boundary of the text in the input file. The teachings of Fitzpatrick are clearly analogous and combinable with those of Sato, so far as the process of Fitzpatrick would have been able to allow the text to converted to an audio media. The benefit provided by the underlying process of Fitzpatrick, so far as is applicable to Sato and applied in the final rejection, does not hinge on the inclusion or exclusion of any such non-discernable data.

On page 8, lines 13-17, the applicant has stated, "If Fitzpatrick did, as the Office Action claims, teach 'concatenating at least a portion of an audio format of the descriptive information to the audio file' such that the initial audio and metadata were contained in an input audio file, then no non-discernable data would be present in such input file, and the motivation behind the Fitzpatrick disclosure would be obviated". Again, the examiner respectfully notes that this argument is moot since Fitzpatrick, *alone*, was never said to teach or suggest this limitation. Rather, such a limitation was rejected taking the teachings of Sato in further consideration of Fitzpatrick, as is discussed at length above. Further, the allegation of "the motivation behind the Fitzpatrick disclosure would be obviated" is not pertinent to the present prosecution; the rejection is based on what Fitzpatrick *does* teach, not what Fitzpatrick *may or may not have taught* if the input file comprised only audio and text. This

Art Unit: 2644

statement by the applicant concerning the 'motivation to yet disclose' of Fitzpatrick amounts to mere conjecture, not supported or supportable by any evidence or documentation of record. The teachings of Fitzpatrick are applicable to Sato for at least what they *do* teach. The failure to utilize all features of the secondary reference does not preclude the application of the secondary reference in the combination for what is disclosed. The applicant appears to be arguing that recognizing and claiming, as part of the pending claims, latent properties of the system of Fitzpatrick (specifically, the ability to convert audio-text files to audio media) are unobvious because the reference of Fitzpatrick includes additional capabilities. However, it is well established that mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. The applicant's claiming of less than the full capability of Fitzpatrick (in view of and as applied to Sato) does not distinguish or make such claims patentable, nor prevent capabilities of Fitzpatrick from being considered in view of their counterparts of Sato.

On page 8, lines 17-19, the applicant has stated, "combining Fitzpatrick with Sato would obviate the need for Fitzpatrick, because the Sato file would not include non-discernable data". The examiner respectfully disagrees. As discussed above, at least part of the teachings of Fitzpatrick are applicable and can be motivated into analogous aspects of Sato. Arguing additional properties of Fitzpatrick that are not needed (or, alternatively, may be included,

Art Unit: 2644

but would not ever be utilized in formal processing) does not preclude other aspects of Fitzpatrick from being applied to analogous aspects of the teachings of Sato. The motivation provided in Fitzpatrick is at least applicable to the teachings that are relied upon in Fitzpatrick.

On page 8, lines 20-21, the applicant has stated, "Thus, Fitzpatrick does not read on 'generating a new audio file . . .'". The examiner respectfully disagrees. The applicant's remarks do not address nor contradict that the output file of Fitzpatrick (col. 3, lines 22-26, 66-7 and col. 4, lines 1-2 and 58-67), which is written during the processing of the input file, at least suggests 'generating a new audio file containing audio data'. The applicant's remarks, instead, address aspects of Fitzpatrick which were not relied upon for in the final rejection. As noted above, this argument is spurious with regards to the manner in which Fitzpatrick has been applied. Accordingly, writing the 'output file' in Fitzpatrick is understood to at least suggest the generating of the new audio file as claimed, in further view of the simultaneous reproduction (thus, mixing) teachings of Sato in regards to the manner in which data is combined.

On page 8, lines 20-25, the applicant has stated, "'[H]andling of digital audio signals' as asserted in the Advisory Action does not teach, suggest, or disclose the limitation of 'generating a new audio file containing audio data resulting from the mixing'" and "This is true at least for the reason that the claim limitations of Claim 6 make it clear that the claimed mixing is performed in relation to

Art Unit: 2644

'descriptive information' mixed with the initial 'audio file'".

Again, the examiner respectfully notes that this argument is moot since Fitzpatrick, *alone*, was never said to teach or suggest this limitation. Rather, such a limitation was rejected taking the teachings of Sato in further consideration of Fitzpatrick, as is discussed at length above. Sato is particularly relied on for suggesting the 'mixing' type of data combining or handling, as well as the fact that such mixing is performed in relation to 'descriptive information' and the initial audio file (which again, as discussed above, is properly interpreted as the audio contents of an audio file, not the literal whole audio file).

On page 8, lines 25-28, the applicant has stated, "Even if Applicants were to concede to the Advisory Action's characterization that Sato discloses mixing an audio signal, the Advisory Action is fatally flawed because it fails to make a prima facie showing of 'generating a new audio file containing audio data resulting from the mixing'". While the applicant is entitled to this, their own opinion, the examiner respectfully disagrees. Sato in further view Fitzpatrick at least suggests this limitation. Sato discloses generating a new analog audio signal resulting from mixing. Fitzpatrick discloses generating a new digital audio file (and thus, signal) resulting from the combination of audio sound and synthesized text digital signals. Applying the particular type of signal combination or handling of Sato (the mixing) with the format or manner of combining audio signals in Fitzpatrick (through the generation of a

Art Unit: 2644

new file for output) at least suggests the limitation of 'generating a new audio file containing audio data resulting from the mixing'.

Again, Fitzpatrick provides the motivation for utilizing the digital format of such data combining, that hardware capable of efficient, real time processing would not be necessary for this digital style of data handling, as opposed to the simultaneous, real-time handling and output of signals in the system of Sato. It is further noted that the digital handling of signals in Fitzpatrick only requires one D/A converter for output (col. 4, line 67-col. 5, line 1), as opposed to the two necessitated for the system of Sato (para. 0055).

On page 9, the applicant notes the other claims in the application including the dependent claims, though no other further arguments, beyond those which are addressed above, are presented. Accordingly, so far has the applicant's arguments have been addressed above, it is respectfully submitted that such responses also suffice to substantiate the rejection of these other and dependent claims as well, so far as no further arguments or alleged discrepancies are presented by the applicant, nor believed to be present by the examiner. As such, the rejections in further view of Yumura are also appropriate and properly presented in the final office action.

As set forth above, the applicant's attacks against the references individually, as well as the arguments regarding latent properties, are unpersuasive.

Art Unit: 2644

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

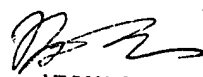
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Conferees:



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